

## **REMARKS**

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the above amendments and following remarks.

### **I. STATUS OF THE CLAIMS AND FORMAL MATTERS**

Claims 1-9 are currently pending. Claims 1-9 are rejected. Claim 1 is hereby amended. No new matter has been introduced. Support for this amendment can be found throughout the Application as originally filed.

The amendments to the claims are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### **II. THE REJECTION UNDER 35 U.S.C. § 112, First and Second Paragraph**

Claims 4-6, 8 and 9 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Particularly, with respect to claims 4, 8 and 9, the Examiner alleges that it is unclear "what specific apparatus structure constitutes the recited arrangement that enables the dewaxing function."

Paragraph [0034] of Applicant's published application discloses:

The plate 26 supports an annular arrangement of vessels 28 for the receipt of respective baskets 29 in which there are placed microscope slides (not shown) with tissue specimens which are to be treated in liquid baths in the

vessels. **The liquid baths consist of suitable reagents for dewaxing and treatment of the tissue specimens. In the illustrated embodiment, ten such vessels 28 are arranged on the support plate 26.** Further, a loading magazine 30 for vessels to be retreated in the apparatus is placed on the plate. In the illustrated embodiment the loading magazine comprises two stations (station 1 and 2), so that it can receive two baskets at the time. (Emphasis added).

On the basis of the above-provided support for the dewaxing function, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claims 1-9 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In light of the current amendment to claim 1, Applicant hereby submits that this rejection is moot. Reconsideration and withdrawal of this rejection is, therefore, also respectfully requested.

### III. THE REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1, 2, 4, and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,580,056 to Tacha ("*Tacha*") in view of U.S. Patents Nos. 3,800,778 to Lohr et al. ("*Lohr*") and 5,951,900 to Smrke ("*Smrke*").

Claims 3, 7, and 9 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Tacha* in view of *Lohr*, *Smrke*, and further in view of U.S. Patent No. 6,283,015 to Kwon et al. ("*Kwon*").

Claims 5 and 6 were also rejected under 35 U.S.C. § 103(a) as unpatentable over *Tacha*, *Lohr*, and *Smrke*, in further view of U.S. Patent Nos. 6,017,495 to Ljungmann ("*Ljungmann*") and 6,544,798 to Christensen et al. ("*Christensen*").

#### IV. RESPONSE TO REJECTIONS

Claim 1, as herein amended, recites:

“An apparatus for heat treatment of tissue specimens, comprising a pressure cooker (1) for cooking of the tissue specimens, a temperature sensor (5) and a pressure sensor (6) connected to the pressure cooker, and a control unit (15) for time-controlled heat treatment of the tissue specimens in the pressure cooker (1), the control unit (15) being arranged to control a programmed step-by-step heating course, with a programmed time duration on each temperature step, ... and that the control unit (15) also is arranged to control a programmed **step-by-step cooling course**, from the chosen maximum temperature down to a chosen final temperature, **wherein both the programmed step-by-step heating course and the programmed step-by-step cooling course are controlled by the control unit via a data program.** (Emphasis Added)

As indicated in the Advisory Action, regarding claim 1 and the rejection under 35 U.S.C. § 103(a), the Examiner contends that the cooling process is taught by *column 4, lines 14-28* of *Tacha*.

According to *column 4, lines 14-28* of *Tacha*, the processor may be arranged to enable the setting of a plurality of set points, wherein each set point is comprised of a temperature and timer duration. When the start button is pressed, the heating element will be activated until the first set point has been reached, and then deactivated. When the start button is pressed again without turning off the controller, the heating element will be activated again until a second set point has been reached, and so forth. The first set point may be a maximum temperature, and the second set point may be a keep-warm temperature. The second set point may also be a cooling down period in which the temperature is set at 0 to keep the heating element turned off. When the second set point has been reached, the alert is sounded to notify the user that the cooker has cooled and depressurized enough to be opened safely.

*Tacha* does not disclose or suggest “**both** [a] programmed **step-by-step heating course** and [a] programmed **step-by-step cooling course** [that] are controlled by the control unit via a data program [.]” as recited in amended claim 1.

*Tacha* teaches a cooling process by *merely* turning its heating element off and not by providing a “**step-by-step cooling course**” that is “**controlled by the control unit via a data program** [.]” *Tacha* does not, therefore, provide a **controlled** cooling off procedure capable of enabling sufficient control over the cooling process. Thus, the result is that a desired reproducibility is not obtainable under the *Tacha* process:

By way of example and not limitation, paragraph [0031] of Applicant’s published application discloses:

FIG. 2 is a diagram showing an example of a program protocol with process verification. The diagram shows the temperature in the pressure cooker as a function of time during a chosen treatment cycle. As appears, the topical temperature cycles comprise eight phases, wherein the temperature and time duration for the individual phases are as follows:



FIG. 2

As described and illustrated above, **BOTH** a “step-by-step heating course **and** a “step-by-step cooling course are controlled by “[a] control unit via a data program [.]”

Therefore for at least the reasons described above, Applicant submits that claim 1 is patentable over the cited *Taka*, *Lohr*, and *Smrke* references.

#### **IV. DEPENDENT CLAIMS**

The other claims are dependent from independent claim 1 and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

#### **V. CHANGE IN ENTITY STATUS**

Applicants wish to note that the above referenced application is no longer entitled to claim small entity status. All future payments are to be made at according to large entity fees.

#### **CONCLUSION**

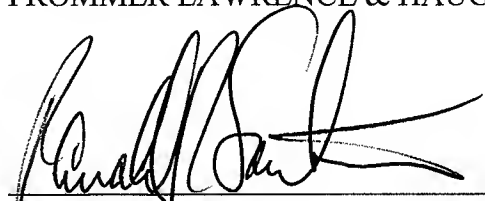
In view of the foregoing, it is believed that all of the claims in this application are patentable over the prior art, and an early and favorable consideration thereof is solicited. Because Applicant maintains that all claims are allowable for at least the reasons presented hereinabove, in the interests of brevity, this response does not comment on each and every comment made by the Examiner in the Office Action. This should not be taken as acquiescence of the substance of those comments, and Applicant reserves the right to address such comments

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicants' undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

Please charge any fees incurred by reason of this response and not paid herewith to  
Deposit Account No. 50-0320.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

By:

A handwritten signature in black ink, appearing to read 'Ronald R. Santucci', written over a horizontal line.

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